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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,579	12/20/2001	Frank F. Molock	VTN 571	1779
27777	7590	03/17/2004	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			VARGOT, MATHIEU D	
			ART UNIT	PAPER NUMBER
			1732	

DATE MAILED: 03/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,579

Applicant(s)

MOLOCK ET AL.

Examiner

Mathieu D. Vargot

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 1-23 and 31-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 24-30 and 41 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-23, drawn to a colorant, classified in class 524, subclass 120.
- II. Claims 24-30 and 41, drawn to as method for making a tinted contact lens, classified in class 264, subclass 1.7.
- III. Claims 31-39, drawn to a mold, classified in class 249, subclass 114.1.
- IV. Claim 40, drawn to a lens, classified in class 351, subclass 162.

The inventions are distinct, each from the other because:

Inventions I/II, I/III and I/IV are separate or distinct in that they have different utility in the art and do not necessarily need to be used together. For instance, the composition of Group I has other utility than being used in the process of Group II or as a mold coating as set forth in Group III. For instance, the colorant and binding polymer can be used in general molding processes to make other than contact lenses or optical articles and can be masterbatched with a polymer and need not be used as a mold coating.

Inventions II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used in other processes such as the molding of other than contact lenses—ie, IOLs and other discs which would not even have an optical function.

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Inventions II and IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by other processes such as applying the pigment formulation to a prepolymerized lens blank (and not the mold) and then fully polymerizing the lens.

Inventions III and IV are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the product as claimed can be made in a mold with no coating—ie, the pigment dispersion can be added onto an already prepolymerized lens blank outside a mold.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Ms. Harding on March 5, 2004 a provisional election was made with traverse to prosecute the invention of Group II, claims 24-30 and 41. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-23 and 31-40 have been withdrawn from further

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consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 24 and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Thakrar et al (see col. 2, line 64 through col. 3, line 12; col. 3, line 45 through col. 4, line 17; column 5, lines 7-19).

The applied reference discloses the instant method for manufacturing a tinted contact lens by applying a pigment dispersion in a binding polymer and solvent to the surface of a mold, adding the lens material and polymerizing the material—see passage bridging columns 2 and 3. The swelling of the colorant dispersion in the lens material is disclosed at column 5, line 15 as a “mechanical altering and softening”. At lines 15-19 of column 5, Thakrar et al teaches that the lens monomer penetrates the binding resin/colorant capsules and at column 6, line 4, it is disclosed that the pattern is “fixedly impregnated within the lens matrix” after curing. It is submitted that these disclosures clearly teach the instant interpenetrating network which results from the polymerization

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of the lens material around the pigment/binding polymer. It is submitted that the pigment is wetted with the binding polymer as recited in instant claim 41.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thakrar et al.

Thakrar et al discloses the basic claimed method lacking essentially a clear disclosure of the instant binding polymers and molecular weight therefor and the instant solvents. Column 3, lines 46-57 teaches suitable resins for the binding polymer, among them PMMA and polyhydroxyethyl methacrylate; HEMA is disclosed at column 5, line 31 as a material for the lens; and suitable solvents are taught at column 3, lines 58-62. It is submitted that the instant materials would have been obvious material selections over those disclosed in Thakrar et al.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Barrera et al discloses IPNs for pigment dispersions. Fuhrman teaches a method in which a lens material is mixed with a pigment and binding polymer and entraps the pigment so that the colorant is non-migrating—see col. 3, lines 44+ of the reference. It is submitted that this process also forms an IPN between the lens material and the pigment. Lim discloses IPNs for contact lenses and Neefe incorporates fluorescent dyes into a contact lens polymerizate.


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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni, can be reached on 571 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot
March 5, 2004


Mathieu D. Vargot
Primary Examiner
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3/5/04